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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,918	10/02/2003	Binz DeWalch	D30972US	9571
28805 7590 02/20/2008 ARNOLD & KNOBLOCH, L.L.P. 2401 FOUNTAIN VIEW DRIVE SUITE 630 HOUSTON, TX 77057			EXAMINER HANDY, DWAYNE K	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 02/20/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/677,918	Applicant(s) DEWALCH, BINZ	
	Examiner DWAYNE K. HANDY	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-157 is/are pending in the application.
- 4a) Of the above claim(s) 35-127 and 143-157 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 128-142 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-157 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-34 and 128-142, in the reply filed on 11/26/07 is acknowledged. The traversal is on the ground(s) that the Restriction Requirement has changed. This is not found persuasive because Applicant has not argued the grounds of Restriction between the various groups. The requirement is still deemed proper and is therefore made FINAL.

The Examiner notes Applicant's objection and traversal of the new Restriction Requirement. The Examiner did contact Mr. Arnold in December of 2005 but the call did not result in the election of a Group at that time. Mr. Arnold asked the Examiner to reconsider the original groupings. The Examiner reconsidered the groupings in the meantime which resulted in the written Restriction Requirement mailed 6/26/07. Applicant should (and apparently did) consider the written Restriction from 6/26/07 as the official restriction requirement being made at this time.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-30, 32-34, 129-131 and 133-142 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 19-21, 24, 25, 32, 34, 129-131 and 133-142 refer to the "system as in claim 1, 2, 4 or 10" but contain

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means for limitations that appear to correspond to the limitations of the system of claims 18, 128 or 132. Claim 33 refers to claim 21 which refers to claim 1. Claims 1, 2, 4 and 10 recite a device.

Claims 26-30 refer to "the system as in claims 6, 8, 6, 17 and 30" but contain means for limitations that appear to correspond to the limitations of the system of claim 18. Claims 6, 8, 7 and 30 recite a device.

Claims 22 and 23 refer to "claim 4A" and "claim 4B".

For Examination purposes, the Examiner assumed that claims 19-33 are supposed to depend from claim 18, claims 129-131 should depend from claim 128, and claims 133-142 are to depend from claim 132.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4-23, 25-34, 128-135 and 140-142 are rejected under 35 U.S.C. 102(b) as being anticipated by Stylli et al. (5,985, 214). Stylli teaches a system

and method for utilizing automated and integrated workstations to synthesize and identify compounds. The system is best shown in Figures 4, 5, 7, 17, 19A and 19B. The embodiment shown in Figure 4 includes a conveyor means (210) for transporting plates to a bar code reader (230), a lid removal/replacement station (250), liquid handlers (240) and plate stackers (column 17, lines 20-36). The dispensing module is described further in column 12, line 4 – column 17, line 19 and includes a teaching of the use of stops (reference points and detectors) in column 14, lines 1-45. Figures 19A and 19B show (see also column 61, lines 4-42) dispensing elements having protrusions (1920). Stylli recites the use of a conveyor system having multiple lanes for delivering the samples in column 17, line 37 – column 20, line 43. The Examiner considers the lid removal/replacement station to meet the limitation of a plate sealer or a seal positioned and arranged for contact or interaction with the plate. The Examiner considers a dispensing element that extends into the well to allow aspiration as meeting the limitation of a piercing element since it could pierce a flexible seal.

6. Claims 1, 2, 4, 10-21, 30-34 and 128-133 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganz et al. (6,148,878). Ganz teaches an automated device for filling and storing microplates. The device is best shown in Figures 4, 5 and 10-39. The device includes a plurality of input chambers (15) and a plurality of output chambers (16) for holding stacked microplates, a dispensing element (13), a lid lifter (41) and a walking beam indexer (7) for moving the plates between the stations. The Examiner considers the lid removal/replacement station to meet the limitation of a plate sealer or a

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seal positioned and arranged for contact or interaction with the plate. The Examiner considers the use of sensing elements at each station to stop and align the plates as meeting the limitation of a stop (column 6, lines 25-38).

7. Claims 1, 2, 4-23, 25-34, 128-137 and 140-142 are rejected under 35 U.S.C. 102(e) as being anticipated by Marquiss et al. (6,902,703). Marquiss teaches an integrated sample processing system. The system is best shown in Figures 18, 24-33, 40-43 and 48. The system includes a dispensing module(s), sample containment (sealing) module, storage module, and a transport module for transporting a plate or other sample holder between the other modules. The transport module is described in columns 11-16. In column 16, Marquiss teaches a shuttle mechanism that includes a tray, motor, belt and guideshaft for guiding the tray with the sample plate. The sealing station is shown in Figures 40-43 and described in column 32, line 60 - column 35, line 13. The Examiner considers the sealing station to meet the limitation of a plate sealer or a seal positioned and arranged for contact or interaction with the plate. Marquiss discloses a wide variety of dispensing elements in columns 18-29.

### ***Conclusion***


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE K. HANDY whose telephone number is (571)272-1259. The examiner can normally be reached on M-F 8:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DKH  
February 19, 2008

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700